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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,234	12/16/2003	Frank Bonadio	08203.0033	3142
22852	7590	07/25/2008	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			RAMANA, ANURADHA	
ART UNIT	PAPER NUMBER			
			3733	
MAIL DATE		DELIVERY MODE		
07/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/736,234	Applicant(s) BONADIO ET AL.
	Examiner Anu Ramana	Art Unit 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 07 May 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-15,17-24,26-35 and 38-41 is/are pending in the application.
 - 4a) Of the above claim(s) 17 and 19 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-15,18,20-35 and 38-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 December 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/7/08</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 5-7, 13-15, 18, 20-21, 30-31, 34, 35 and 39-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Cuschieri et al. (US 5,480,410).

Cuschieri et al. disclose an iris valve or surgical device including: a mounting element having a first ring element 17; second ring element 16 located within the first ring element and having a gear or rib 18 locatable in a recess or groove in the other ring element; and a sealing member 13 of pliable material mounted to the mounting element, wherein the sealing member has a normally closed opening as illustrated in Fig. 4a (Figs. 1 and 3a-4b, col. 3, lines 34-67 and col. 4, lines 1-45).

The method steps of claims 34 and 35 are inherently performed when the Cuschieri et al. device is used to perform a surgical procedure.

Regarding claim 40, the Examiner notes that insertion of an object through the closed opening would cause the rings to move relative to one another, thereby untwisting the sleeve.

Claims 8-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hood et al. (US 5,261,883).

Hood et al. disclose a surgical device including: a mounting element with a first ring element 66 and a second ring element 36; a twisted sealing member 40 having a normally closed access opening; and a spring element 81 extending between the first

ring element and the second ring element to bias the sealing member to close the access opening (Figs. 9-10, col. 4, lines 31-68, col. 5 and col. 6, lines 1-17).

Regarding claim 14, Hood et al. disclose the first ring element to have a rib 62 that is locatable in a corresponding groove of second ring element 36.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 20-24, 26-35 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beane et al. (US 5,906,577) in view of Cuschieri et al. (US 5,480,410).

Beane et al. disclose a retractor or "mounting element" including a first ring member and an inflatable collar or "second ring member" and a sealing sleeve wherein the attachment means between the retractor and the sealing sleeve could include a compression or threaded fit, i.e., "comprises a groove." Beane et al. further disclose the sealing sleeve could be a mechanical sealing means well known in the art, for example, an iris valve (Figs. 1, 5, 6A, 6B, col. 9, lines 7-67 and col. 10, lines 1-49).

Beane et al. disclose all elements of the claimed invention except for an iris valve with a normally closed access opening.

Cuschieri et al. teach mechanical sealing means such as iris valves that may be fixed wherein the valve is always biased closed or wherein the iris valve is adjustable to accommodate larger objects (col. 4, lines 24-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a mechanical sealing means, as taught by Cuschieri et al., wherein the valve is biased closed by providing either a fixed or an

adjustable iris valve, to ensure a seal with an inserted object, irrespective of the size of the inserted object.

The method steps of claims 34 and 35 are rendered obvious by the above discussion.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on May 7, 2008 have been fully considered but are moot in view of the new grounds of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
July 21, 2008

/Anu Ramana/
Primary Examiner, Art Unit 3733